REMARKS/ARGUMENT

Request for Extension of Time:

A Request for Extension of Time has been submitted herewith.

Regarding the Claims in General:

Claims 30-39 remain pending, claims 1-29, and claims 40-43 having previously been canceled. Claims 30 and 31 have been amended as discussed below. The other claims remain unchanged.

Regarding the Objection to Claim 30:

Claim 30 has been amended to correct the error noted by the Examiner.

Regarding The Allowable Subject Matter

Applicant notes with appreciation the allowance of claims 32-38, and the indication that claim 31 would be allowed if amended or rewritten to incorporate the limitations of its parent claim 30. Claim 31 has accordingly been amended to incorporate the limitations of claim 30.

Regarding the Double Patenting Rejections:

In the outstanding Office Action, claim 39 is now rejected on the doctrine of obviousness-type double patenting in view of claims 32 and 37 of U. S. patent 5,417,370. Applicant respectfully traverses this rejection.

The Examiner's attention is respectfully directed to the Table below which demonstrates that claim 39 herein is not merely an obvious variation of claims 32 and 37 of the '370 patent.

Lim.	Claim 39	'370 Claim 32	'370 Claim 37
(a)	an output driving ring	an output gear	an output gear . . . mounted for rotation in either direction

Lim.	Claim 39	‘370 Claim 32	‘370 Claim 37
(b)	two counter rotating gears	. . . two drive gears, a first drive gear and a second drive gear for alternate driving engagement with said output gear . . .	a first drive gear and a second drive gear
(c)	a gear carrier for alternately shifting one or the other of the two counter rotating gears into driving engagement for driving the output driving ring to oscillate the output driving ring	a gear cage . . . means mounting said gear cage for movement, toggle means for alternately moving said gear cage in one direction to drivingly engage said first drive gear with said output gear or in the other direction to drivingly engage said second drive gear with said output gear [to oscillate it]	a gear cage . . . means mounting said gear cage for movement between a first and second drivingly engaged position [for alternately driving said output gear . . . between a first and second angular position]
(d)			toggle means for alternately moving said gear cage
(e)	a first spring for biasing the gear carrier in either direction; and	first biasing means for biasing said toggle means and said gear cage in one direction or the other direction, and	first biasing means for alternately biasing said toggle means and gear cage in one direction to the other toward its first or second drivingly engaged position, means for removing the bias of said first biasing means from said gear cage during the movement of said output gear to its first or second angular position, and

Lim.	Claim 39	'370 Claim 32	'370 Claim 37
(f)	a second spring for biasing the gear carrier in one of the directions to maintain one of the drive gears in driving engagement with the output driving ring when the biasing force of the first spring against the gear carrier is removed during shifting of the gear carrier to the other direction.	second biasing means for biasing said gear cage in at least one direction to place and maintain said first drive gear in driving engagement with said output gear when said first means for biasing has been removed.	second biasing means for directly biasing said gear cage in said one direction towards its first drivingly engaged position to maintain the gear cage biased in said one direction when the bias of said f-'rst biasing means has been removed to move said gear cage in said other direction at least until said first biasing means is biasing said gear cage in said other direction.

The underlying premise of the double patenting rejection appears to be that claim 39 herein is purportedly broader than claims 32 and 37 of the '370 patent (see Office Action, page 3, lines 4-5). Consider, however, limitation (a) above: claim 39 calls for "an output driving ring", while both patent claims recite "an output gear". In this respect alone, claim 39 is narrower.

Similarly, limitation (b) of claim 39 is "two counter rotating gears". In the corresponding portions of claims 32 and 37 of the '370 patent, counter rotating gears are not mentioned.

Considering limitation (c) of present claim 39, this is structural form while the corresponding portions of claims 32 and 37 of the '379 patent are in means-plus-function form. The latter form is inherently broader. In this regard, the Examiner is respectfully referred to the observation of the court in *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.,* 234 F.3d 558, 56 USPQ2d 1865 (CA FC 2000), that merely replacing means-plus-function language with a recitation of the corresponding structure, effectively narrows the scope of the claim. In *Festo,* the court stated:

> A claim element recited in means-plus-function language literally encompasses the corresponding structure and its equivalents. (citing *Laitram Corp. v. Rexnord Inc.,* 939 F.2d 1533, 1536, 19 USPQ2d 1367, 1370 (Fed. Cir. 1991)). In contrast, a claim element that recites the corresponding structure does not literally encompass equivalents of that structure. . .Thus, a claim amendment that replaces means-plus-function language with language reciting the corresponding structure narrows the literal scope of the claim.

234 F. 3d at 589, 56 USPQ2d at 1888.

Claim 39 is thus also narrower than claims 32 and 37 of the '370 in respect to limitation (c) as well. Similar remarks apply with respect to limitations (e) and (f) of claim 39.

In view of the foregoing, it is respectfully submitted that claim 39 herein does not encompass claims 32 and 37 of the '370 patent, and is not an obvious variation thereof. The double patenting rejection should therefore be withdrawn.

Further in this connection, the Examiner's attention is respectfully drawn to a judicial interpretation of the means-plus-function language of several of the claims of the '370 patent in *Carl Kah et al. v. Rain Bird Sprinkler Mfg. Corp.,* Case No. 95-Cv-8492, U.S. District Court, Southern District of Florida, *Affd. per curiam, Carl Kah et al. v. Rain Bird Sprinkler Mfg. Corp.,* 98-1468, -1469, U.S. Court of Appeals for the Federal Circuit, May 7, 1999; *Petition for Reh. Denied; Suggestion for Reh. in banc Declined,* June 15, 1999. Here, in the context of 35 U.S.C. 112, sixth paragraph, the trial court, in substance, interpreted the term "biasing means" in claim 159 to mean only an "Ω" shaped spring, and not springs of any other shape. There was no formal opinion reflecting this decision, but the jury was so instructed.

Regarding the Prior Art Rejection:

In the outstanding Office Action, claims 30 and 39 are rejected as anticipated by Hunter U.S. Patent 4,568,024 (Hunter), which he says discloses ". . . all the featured elements of the instant invention . . ." The rejected claims, however both recite features not disclosed, taught or suggested in Hunter.

Preliminarily, it is noted that Hunter and the present application are concerned with different problems. Hunter is concerned with balancing the forces required to move the reversing gear mechanism for both reversal directions (see e.g., col. 1, lines 19-38). The present invention, in contrast is concerned with preventing the reversing mechanism from stalling in the middle of the reversal whereby the sprinkler head is immobilized, and can not oscillate. There is no mention at all of this in Hunter, and correspondingly, no mechanism in Hunter designed to address this problem.

The solution to applicant's problem is broadly embodied in claims 30 and 39. Specifically, claim 30 calls for:

> a biasing mechanism for retaining the shiftable carrier in a selected one of said driving positions until the shiftable carrier is shifted to the other driving position by said shifting arm.

Hunters' springs 56 do not do this. As soon as lever tip 66 engages with one of shoulders 68 or 70, the shifting process starts, and the corresponding one of drive pinions 46 or 50 disengages with ring gear 30. This is precisely what causes the potential for stalling. The claimed biasing mechanism prevents this, and accordingly, claim 30 is not anticipated by Hunter.

Similarly, claim 39 calls for:

> a second spring for biasing the gear carrier in one of the directions to maintain one of the drive gears in driving engagement with the output driving ring when the biasing force of the first spring against the gear carrier is removed during shifting of the gear carrier to the other direction.

As explained in connection with claim 30, this concept is entirely foreign to Hunter. Thus claim 39 is also not anticipated by Hunter.

In view of the foregoing, favorable reconsideration and allowance of this application are respectfully solicited.

Respectfully submitted,

THIS CORRESPONDENCE IS BEING SUBMITTED ELECTRONICALLY THROUGH THE PATENT AND TRADEMARK OFFICE EFS FILING SYSTEM ON October 10, 2006.

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